Attorney Docket No. P12240

REMARKS/ARGUMENTS

1.) Claim Status

Claims 1 through 19 are pending in the application. They have not been amended, but a courtesy copy of the claims is provided above.

2.) Claim Rejections – 35 U.S.C. § 102(b)

The Examiner rejected claims 5, 6 and 8 under 35 U.S.C. § 102(b) as being anticipated by Gundersen European Patent Application No. EP 0781058 (hereinafter called Gundersen). The Applicant respectfully traverses this rejection and incorporates by reference the Applicant's previous response filed on February 9, 2004.

As previously stated by the Applicant in the February 9, 2004 response, Gundersen does not disclose nor teach a database for storing a plurality of "segmentation support capability test results". The term "segmentation support capability test results" is defined on page 11 of the Applicant's specification:

> The node 20 maintains a database 40 by sending out segmentation support test messages to other nodes 20' in the network *and waiting for receipt of the segmentation support response messages* indicating that the other nodes 20' are capable of supporting receipt of segmented messages.

Thus, a database storing "segmentation support *capability* test results" generated by the receipt of a segmentation support response message is not an error log. This term refers to a specific process regarding segmentation support *capability* of the relevant nodes. Obviously, such a process is different than an error log which simply records whether the sending of a message was successful.

In support of the Examiner's previous rejection for claim 5, the Examiner states that Gundersen discloses a system comprising:

> a first node (40, fig. 1) having a memory (41) including a database (feature table set 53) for storing a plurality of segmentation support capability test results, wherein the first node is adapted to send a segmented message and a segmentation support test message, and to

receive a segmentation support response message (page 3, lines 18-25; page 4 lines 23-24, 47-49).

Regarding the database, Fig. 1 of Gundersen simply shows a box labeled "Feature Table Set 53." There is no discussion in Gundersen regarding this database nor is there a meaningful discussion of the first node 40. The Examiner's other citation on page 3 is reproduced below:

> Furthermore, the interpreter waits for returned messages from the platform supporting new SCP or SDP software modules and compares the data values contained in the return messages against the expected values specified in the script file. If there is a mismatch, an error message is generated.
>
> In one aspect, the present invention includes a method and apparatus for generating TCAP message using a natural script language to test a telecommunications software module.
>
> In another aspect, the present invention includes a method and apparatus for comparing a received TCAP message with a user specified test message written in natural script language to verify whether a telecommunications software module performed correctly.

The Examiners citation on page 4 is also reproduced below:

> The interfaces between SSPs 30 and the SCP 70 are by links 60 utilizing the SS7 Transaction Capabilities Application Part (TCAP) as the application layer protocol. TCAP messages enable telecommunications nodes to intercommunicate application level data in order to provide special subscriber services. . . .
>
> In accordance with the Kite application, FIG. 2 is a block diagram of a test system illustrating a simulator 200 substituting for a node in the IN system and connecting to an SCP 70 or SDP 100. In order to test new software modules for the SCP 70 or SDP 100, there is no need to provide a real SSP 30 as long as the simulator can generate and transmit the necessary TCAP messages to effectuate the internal execution of the new software modules. Such a TCAP generator can read off TCAP messages from a test script file and transmit the messages over a communication link.

None of the above cited passages teach a "a database for storing a plurality of segmentation support capability test results." In Gundersen, whenever a new software module needs to be installed on a live SCP/SDP, the new module must go through tremendously arduous functional test procedures to verify and guarantee that such a

module will perform correctly (p. 4, lines 35-40). However, Gundersen does not describe a system having a memory for storing a plurality of *segmentation support capability test results*. In Gundersen, error messages resulting from a detection of a false execution of a software module are stored in a log file. This is not the same element as storing "segmentation support capability test results."

This argument was presented in the Applicant's response filed on February 9, 2004. In response, the Examiner states "There is no difference between the claimed database and the feature table set in Gundersen because there is not found how the database was defined, the database in general would be a table with data entry or feature set."

The Applicant respectfully disagrees with this statement. The relevant element of claim 5 states: "a database for storing a plurality of segmentation support capability test results." The examiner cannot ignore or redefined the functional limitations of this claim element. According to the MPEP:

> A functional limitation is an attempt to define something by what it does, rather than by what it is. . . . *A functional limitation must be evaluated and considered*, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context for which it is used.
>
> MPEP 2173.05(g)

Thus, according to the MPEP, the functional limitation of "*for storing a plurality of segmentation support capability test results*" must be evaluated and considered by the Examiner. The Applicant respectfully submits that the Examiner is, in fact, not considering this functional limitation of claim 5. *Thus, the Applicant respectfully requests that the Examiner consider the functional limitations of claim 5.*

In reply to the Applicant's previous arguments regarding whether Gundersen teaches a system having a memory for storing a plurality of segmentation support capability test results, the Examiner states: "In reply, the Applicant admitted that error messages (segmentation support capability test results){abstract, lines 13-14, page 3, lines 18-25} resulted from a detection of a false execution of a software module is stored in a log file (memory) in Gundersen. . . . Applicant is directed to figure 1 wherein a system (electronic switch, fig. 1) having a memory (41) for storing a plurality

of segmentation support test results (in feature table sets 53-55, fig. 1; tables 2-3, appendix B)."

First, as discussed above, "segmentation support *capability* test results" are not the same as an error log file. Second, the Applicant emphasizes that Gundersen does not even contain a discussion of figure 1. The boxes labeled "Feature Table Set" in Fig. 1 are not discussed in Gundersen. Table 2, cited by the Examiner, is labeled "Operation Tags and Parameters." Table 3 is labeled "Parameter Default Table." Thus, it is clear that Gundersen does not describe a system for storing a plurality of segmentation support capability test results.

In the Applicant's previous response, the Applicant also argued that element 53 of Fig. 1 in Gundersen would not be an enabling reference, and therefore, could not be used to maintain a §102 rejection. In response, the Examiner states "In reply, Gundersen is a valid U.S. patent, therefore, it is an enabling reference and it does teach all the limitations of claim 5."

The Applicant respectfully asserts the Examiner's citation is a patent application - NOT a patent. Furthermore, Gundersen is an EUROPEAN patent application – not a "valid U.S. patent" as asserted by the Examiner. As is commonly known, European patents do not have to meet U.S. enabling requirements, thus, even if Gundersen were a valid European patent, it would not necessarily be an enabling reference. Additionally, the Applicant is not aware of any authority (case or reference in the MPEP) which states that the mere mentioning of a term in a U.S. patent makes that U.S. patent an enabling reference for the term. It is respectfully, asserted that U.S. patents are enabling references for what they *claim.* They are not necessarily enabling references for every term which may be mentioned in passing in the drawings or specification.

To sustain a §102 rejection, ALL elements of claim 5 must be taught by the cited art and the reference must be enabling. As the Federal Circuit held:

> Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. . . . In addition, the *prior art reference must be enabling*, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) (Emphasis Added)

In light of the above, it is obvious that the Examiner did not seriously consider the Applicant's previous remarks regarding whether Gundersen is an enabling reference. *Therefore, the Applicant respectfully requests that the Examiner adequately respond to the Applicant's remarks regarding the fact that Gundersen is not an enabling reference for the purposes of teaching a database for storing a plurality of segmentation support capability test results.*

In any event, a 102 rejection is not appropriate in this situation because all the elements of claim 5 are simply not taught by Gundersen. Claims 6 and 8 depend from amended claim 5 and recite further limitations in combination with the novel elements of claim 5. Therefore, the allowance of claims 6 and 8 is respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 4, 9-11, 14 and 16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,737,517 (hereinafter called Kite) in view of European Patent Application No. EP 0781058 (hereinafter called Gundersen). The Applicant respectfully traverses this rejection and requests a reconsideration of the pending claims.

Claim 1 states:

> 1. A node supporting message transport and segmentation in a communications network having a plurality of nodes, comprising:
> a memory including a database for storing a plurality of segmentation support capability test results, wherein the memory further includes a program module adapted to send a first segmented message, a first segmentation support test message, and a first segmentation support response message, and to receive a second segmented message, a second segmentation support test message, and a second segmentation support response message.

In contrast, Kite appears to be a system and method for testing a new software module external to an Intelligent Network (IN) within which the software module is to be installed. For doing, so Kite utilizes a TCAP simulator and a non-telecommunication link. The IN network of Kite comprises SCPs, SDPs and SSPs. A new software module can be installed in a SCP and/or a SDP and/or a SSP. In Kite, whenever a TCAP message is generated and transmitted over a Local Area Network (LAN), the messages

are logged into a log file for future reference. Afterwards, Kite verifies the proper execution of the new software module.

However, Kite does not teach a memory including a database *for storing a plurality of segmentation support capability test results*. Kite is merely a system and method for testing an IN network and more particularly for installing a new software module in an IN network. As discussed above, Gundersen also does not supply the missing claimed elements. Thus, the combination of Gundersen and Kite still do not teach all of the elements of the claimed invention.

The invention of independent claim 1 is a node claim, which comprises similar limitations as disclosed in claim 5. Furthermore, independent claim 9 is a method claim, which comprises similar limitations as described in claim 5. Since Gundersen and Kite do not teach all of the elements of the claimed invention, the combination of Gundersen and Kite cannot possibly render obvious the presently claimed invention. Thus, the Applicant respectfully requests that the 103 rejection be withdrawn.

Claims 2, 4, 10, 11, 14 and 16 depend from claims 1 and 9 and recite further limitations in combination with the novel elements of claims 1 and 9. Therefore, the allowance of claims 2, 4, 10, 11, 14, and 16 is also respectfully requested.

The Examiner also rejected claims 3, 7 and 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,737,517 (hereinafter called Kite) and/or European Patent Application No. EP 0781058 (hereinafter called Gundersen) in view of U.S. Patent No. 5,898,667 (hereinafter called Longfield).

Gundersen and Kite do not describe all of the elements of the claimed invention. Longfiled, however, does not supply the missing elements. Thus, the combination of Gundersen, Kite and Longfield cannot possibly render obvious the presently claimed invention. Therefore, Applicant submits that claims 3, 7 and 15, which depend directly or ultimately from claims 1, 5 and 9 are non obvious and thus patentable for the same reasons provided in support of claims 1, 5 and 9. Applicant kindly requests withdrawal of the rejection.

The Examiner rejected claims 12-13 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,517 (hereinafter called Kite) and/or European Patent Application No. EP 0781058 (hereinafter called Gundersen) in view of

Routing and Congestion Control in Common Channel Signaling System, IEEE 1992 (hereinafter called Jabbari). The Applicant respectfully traverses this rejection and requests that the Examiner reconsider the claims in light of the following remarks:

As described above, Gundersen and Kite do not describe all of the elements of the claimed invention and Jabbari does not make up for the missing elements. Thus the combination of Gundersen, Kite and Jabbari cannot possibly render obvious the presently claimed invention. Therefore, Applicant submits that claims 12-13 17-19, which depend directly or ultimately from claims 1, 5 and 9 are non obvious and thus patentable for the same reasons provided in support of claims 1, 5 and 9. Applicant kindly requests withdrawal of the rejection.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

In summary, if the Examiner still feels that allowance of the pending claims is not proper, then the Applicant respectfully requests that:

(1) the Examiner consider the functional limitations of claim 5 and formulate a response according to the standards laid out in the MPEP;

(2) the Examiner properly respond to the Applicant's remarks regarding whether Gundersen is an enabling reference for the purposes of teaching a database *for storing a plurality of segmentation support capability test results*; and,

(3) the Examiner remove the "Final Rejection" status from the this case so that the Applicant may have an opportunity to respond to the Examiner's responses.

The Applicant requests a telephonic interview with the Examiner if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

6-21-04

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